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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/280,601 03/29/99 YANG

Z OPT-20500

EXAMINER

IM52/0403

DELIO & PETERSON
121 WHITNEY AVENUE
NEW HAVEN CT 06510

SERGEANT R

ART UNIT

PAPER NUMBER

13

1711

DATE MAILED:

04/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/280,601

Applicant(s)
Yang et al.

Examiner
Rabon Sergeant

Group Art Unit
1711

☒ Responsive to communication(s) filed on Dec 11, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 23-58 and 80-135 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 23-58 and 80-135 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1711

1. Claims 121-123 and 133 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' definition of R_3 is confusing in that applicants state that R_3 is an organic group consisting of aliphatic or alicyclic and aromatic hydrocarbons. Applicants have omitted the Markush terminology of the previous claims.

2. Claim 123 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The subject matter of claim 123 fails to further limit claim 121, because tri- and tetraacrylate polyene monomers have been specified in claim 20, from which claim 121 depends.

3. Claim 129 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within line 2, "composition" has been spelled incorrectly.

4. Claims 134 and 135 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within line 4, "is" has been omitted between "which" and "solution".

Art Unit: 1711

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

6. Claims 116-135 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,008,296. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is drawn to a composition comprising equivalent reactants.

7. Claims 134 and 135 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have claimed a curable monomer composition; however, applicants further refer to the solution or bulk polymerization of the composition. Firstly, it is unclear that the polymerization language refers to producing the terpolymer. Secondly, it is unclear that claim 134 is directed to anything other than the monomer composition. It is unclear how the polymerization language further modifies the composition. The polymerization language would only pertain to the terpolymer.

Art Unit: 1711

8. Claims 116, 117, 124-132, 134, and 135 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have failed to indicate where support exists for stating that the polyene contains only vinyl functional groups. Within the parent application, this language was specified with a structural formula for the polyene, which contained only vinyl functional groups.

9. The prior art rejection set forth within paragraphs 6-8 of the Office action of September 13, 2000 has been withdrawn in view of the claim limitation requiring the polyene to have only vinyl functional groups.

10. Claims 23-58 and 80-115 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner has not found support for the range of polythiol compounds represented by formula (1) within claims 23, 27, and 55. Also, clear support has not been found for the terminology, "neither a hydroxyl group nor a mercapto group", within claims 23, 27, 55, 80, 84, and 112. The position is taken that the disclosure of a number of specific compounds which lack a hydroxyl or mercapto group is not sufficient to provide support for an entire genus of compounds. Lastly, support had not been found for the whole ratio range of claims 26, 30, 83, and 87.


Art Unit: 1711

11. Applicants' arguments have been considered. While the arguments may have merit with respect to the issue of an interference, they are not sufficient to resolve the 35 USC 112, first paragraph issues. The disclosure must provide full support for the claimed subject matter.

12. Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

Sergent/LR

March 22, 2001


RABON SERGENT
PRIMARY EXAMINER